

Remarks

Claims 1 – 55 are pending in the subject application. In above-noted Office Action entitled "Notice of Allowance and Fees(s) Due" Applicants were advised of an "Examiner's Amendment" canceling Claims 29, 45 and 59. These claims were said to be "improperly dependent product-by-process claims ... [which] do not further limit the claimed method steps".

Applicants do not consent to this Examiner's Amendment therefore Claims 29, 45 and 59 remain in the subject application. Claim 27, although said to be allowed, is also a product-by-process claim which depends from a method claim. Applicants presume that Claims 29, 45 and 59 are thus effectively rejected under paragraph 2 of Section 112. This "rejection" is respectfully traversed.

As indicated by the Examiner, Claims 29, 45 and 59 are each product-by-process claims as is Claim 27, each of which depends directly from a method claim. By way of example, Claim 28 is directed to a method of conditioning a stack of sheets, with "rejected" Claim 29 reciting "A stack of sheets conditioned in accordance with the method of Claim 28".

This approach for presenting product-by-process claims is well known and is believed to be appropriate. By way of example, Scripps Clinic & Research Foundation v Genentech Inc., 927 F.2d 1565, (Fed Cir 1991) is a very well known Federal Circuit case specifically dealing the product-by-process claims. One claim at issue read as follows:

"13. Highly purified and concentrated human or porcine VIII:C prepared in accordance with the method of claim 1." 927 F.2d at 1570.

Claim 1 from which product-by-process Claim 13 depended was, of course, a method claim. The propriety of this form of product-by-process claim drafting was not even an issue in this Federal Circuit case, even though the case specifically dealt with legal issues regarding product-by-process claims. In addition, the Scripps case is cited by Professor Chisum " ... as an example of product-by-process claims in dependent form ..." where the product claim depends from a method claim. Chisum on Patents, § 8.05 at footnote 3.

In that Applicants' approach for the presenting product-by-process claims has been approved by the Federal Circuit, Applicants submit that the "rejection" of Claims 29, 45 and 59 was improper and that Claim 27 is also proper. Also, Applicants have been unable to find any authority in the M.P.E.P. or elsewhere indicating that there has been a change in Patent Office procedure on this point. If there has been a change in policy, Applicants would appreciate citation by the Examiner for authority for such change.

In conclusion, Applicants submit that all pending claims are in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,
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